

ESTTA Tracking number: **ESTTA389356**

Filing date: **01/20/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91183698
Party	Plaintiff The Board of Regents, The University of Texas System
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Date	01/20/2011
Attachments	answer to cc 038.pdf ( 9 pages )(789744 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE BOARD OF REGENTS,  
THE UNIVERSITY OF TEXAS SYSTEM,

Opposer,

v.

SOUTHERN ILLINOIS MINERS, LLC,

Applicant.

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Opposition No. 91183196

Opposition No. 91183698

**ANSWER TO COUNTERCLAIMS FOR PARTIAL CANCELLATION OF  
REGISTRATION NOS. 1,228,753, 1,590,813, 1,591,100, 2,992,329 AND 3,397,296**  
**(as related to Opposition No. 91183196)**

Opposer The Board of Regents, The University of Texas System (“Opposer”) hereby responds to each paragraph of Applicant’s Counterclaims as follows:

1. Admitted.
2. Denied.
3. Opposer admits that it owns Registrations No. 1228753, 1590965, 1590813, 1591100, 2992329, and 3397296, but denies any characterization of those marks in this paragraph.
4. Opposer admits that it has opposed Application Serial No. 7703407 (“the Application”) on the basis of its recited registrations, as well as on the basis of its extensive rights acquired through long and continuous use of certain trademarks and service marks including but not limited to the mark MINERS and designs incorporating images of miners and their tools (the “MINERS Marks”). The MINERS Marks have long been a feature of the athletic teams of The University of Texas at El Paso (“UTEP”), which is governed by Opposer, and a

symbol of UTEP in general, and were used, licensed, and famous long before any priority date Applicant may claim for Applicant's mark MINERS.

5. Opposer admits that it has opposed Application Serial No. 77043344 ("the Application") on the basis of its recited registrations, as well as on the basis of its extensive rights acquired through long and continuous use of certain trademarks and service marks including but not limited to the mark MINERS and designs incorporating images of miners and their tools (the "MINERS Marks"). The MINERS Marks have long been a feature of the athletic teams of The University of Texas at El Paso ("UTEP"), which is governed by Opposer, and a symbol of UTEP in general, and were used, licensed, and famous long before any priority date Applicant may claim for Applicant's mark MINERS.

6. Opposer denies the allegations in this paragraph as stated.

7. Denied.

8. Opposer lacks knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and therefore denies them.

9. Denied.

10. Denied.

**ANSWER TO FIRST COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,228,753**

11. Opposer incorporates its answers to paragraphs 1-9 herein by reference.

12. Opposer admits that it owns Registration No. 1228753 for all services recited in that registration but denies the remaining allegations in this paragraph.

13. Denied.

14. Denied.

15. Denied.

16. Denied.

**ANSWER TO SECOND COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,590,813**

17. Opposer incorporates its answers to paragraphs 1-15 herein by reference.

18. Opposer admits that it owns Registration No. 1590813 for all goods recited in that registration but denies the remaining allegations in this paragraph.

19. Denied.

20. Denied.

21. Denied.

22. Denied.

**ANSWER TO THIRD COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 2,992,329**

23. Opposer incorporates its answers to paragraphs 1-21 herein by reference.

24. Opposer admits that it owns Registration No. 2992329 for all goods and services recited in that registration but denies the remaining allegations in this paragraph.

25. Denied.

26. Denied.

27. Denied.

28. Denied.

**ANSWER TO FOURTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,591,100**

29. Opposer incorporates its answers to paragraphs 1-27 herein by reference.

30. Opposer admits that it owns Registration No. 1591100 for all goods recited in that registration but denies the remaining allegations in this paragraph.

31. Denied.

32. Denied.

33. Denied.

34. Denied.

**ANSWER TO FIFTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 3,397,296**

35. Opposer incorporates its answers to paragraphs 1-33 herein by reference.

36. Opposer admits that it owns Registration No. 3397296 for all goods recited in that registration but denies the remaining allegations in this paragraph.

37. Denied.

38. Denied.

39. Denied.

40. Denied.

41. Denied.

**WHEREFORE**, Opposer denies that Applicant is entitled to any of the relief it requests and asks the Board to deny all relief to Applicant. Opposer further prays that Application Serial No. 77034407 be rejected, and that registration of the mark therein be refused.

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**ANSWER TO COUNTERCLAIMS FOR PARTIAL CANCELLATION OF  
REGISTRATION NOS. 1,228,753, 1,590,813, 1,591,100, 2,992,329 AND 3,397,296**  
**(as related to Opposition No. 91183698)**

Opposer The Board of Regents, The University of Texas System (“Opposer”) hereby responds to each paragraph of Applicant’s Counterclaims as follows:

1. Admitted.

2. Denied.

3. Opposer admits that it owns Registrations No. 1228753, 1590965, 1590813, 1591100, 2992329, and 3397296, but denies any characterization of those marks in this paragraph.

4. Opposer admits that it has opposed Application Serial No. 77043344 (“the Application”) on the basis of its recited registrations, as well as on the basis of its extensive rights acquired through long and continuous use of certain trademarks and service marks including but not limited to the mark MINERS and designs incorporating images of miners and their tools (the “MINERS Marks”). The MINERS Marks have long been a feature of the athletic teams of The University of Texas at El Paso (“UTEP”), which is governed by Opposer, and a symbol of UTEP in general, and were used, licensed, and famous long before any priority date Applicant may claim for Applicant’s mark MINERS.

5. Opposer denies the allegations in this paragraph as stated.

6. Denied.

7. Opposer lacks knowledge or information sufficient to form a belief as to the truth of the allegations in this paragraph and therefore denies them.

8. Denied.

9. Denied.

**ANSWER TO FIRST COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,228,753**

10. Opposer incorporates its answers to paragraphs 1-9 herein by reference.
11. Opposer admits that it owns Registration No. 1228753 for all services recited in that registration but denies the remaining allegations in this paragraph.
12. Denied.
13. Denied.
14. Denied.
15. Denied.

**ANSWER TO SECOND COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,590,813**

16. Opposer incorporates its answers to paragraphs 1-15 herein by reference.
17. Opposer admits that it owns Registration No. 1590813 for all goods recited in that registration but denies the remaining allegations in this paragraph.
18. Denied.
19. Denied.
20. Denied.
21. Denied.

**ANSWER TO THIRD COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 2,992,329**

22. Opposer incorporates its answers to paragraphs 1-21 herein by reference.
23. Opposer admits that it owns Registration No. 2992329 for all goods and services recited in that registration but denies the remaining allegations in this paragraph.
24. Denied.
25. Denied.

26. Denied.

27. Denied.

**ANSWER TO FOURTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 1,591,100**

28. Opposer incorporates its answers to paragraphs 1-27 herein by reference.

29. Opposer admits that it owns Registration No. 1591100 for all goods recited in that registration but denies the remaining allegations in this paragraph.

30. Denied.

31. Denied.

32. Denied.

33. Denied.

**ANSWER TO FIFTH COUNTERCLAIM FOR PARTIAL CANCELLATION OF  
REGISTRATION NO. 3,397,296**

34. Opposer incorporates its answers to paragraphs 1-33 herein by reference.

35. Opposer admits that it owns Registration No. 3397296 for all goods recited in that registration but denies the remaining allegations in this paragraph.

36. Denied.

37. Denied.

38. Denied.

39. Denied.

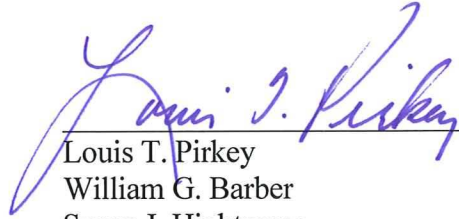
40. Denied.



**WHEREFORE**, Opposer denies that Applicant is entitled to any of the relief it requests and asks the Board to deny all relief to Applicant. Opposer further prays that Application Serial No. 77043344 be rejected, and that registration of the mark therein be refused.

Respectfully submitted,

Date: January 20, 2011

  
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ATTORNEYS FOR OPPOSER

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing ANSWER TO COUNTERCLAIMS FOR PARTIAL CANCELLATION OF REGISTRATION NOS. 1,228,753, 1,590,813, 1,591,100, 2,992,320 AND 3,397,296 has been served via First Class Mail, postage prepaid, on counsel for Applicant at the address below, on January 20, 2011:

Paul A. Lesko  
Jo Anna Pollack  
Stephen Charles Smith  
Simmons Browder Gianaris Angelides & Barnerd  
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